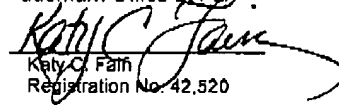


App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Katy C. Fain
Registration No. 42,520

In the Application of: Liedtke, Björn

Ser.No.: 10/018,144

Filed: 14 Decmeber 2001

For: METHOD FOR PRODUCING A DATA CARRIER

Art Unit: 1734

Examiner: SONYA MAZUMDAR

Customer No.: 30996

To: Board Of Patent Appeals and Interference
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria VA 22313-1450

SUBSTITUTE APPEAL BRIEF

The Applicant submits the following for its brief on appeal and respectfully requests consideration of same. The Applicant requests withdrawal of the rejections made and that the Application be placed in line for Allowance.

App. No. 10/018,144
 SUBSTITUTE APPEAL BRIEF
 20 November 2006

TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST	3
II.	RELATED APPEALS AND INTERFERENCES	3
III.	STATUS OF CLAIMS	3
IV.	STATUS OF AMENDMENTS	3-4
V.	SUMMARY OF CLAIMED SUBJECT MATTER	4-5
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL	5-6
VII.	ARGUMENT	7-24
1.	§102(a)--Japanese Patent No. 11-126377 (JP '377)	7-11
2.	§103(a)--U.S. Patent No. 6,200,402 to Amo in view of JP '377	11-15
3.	§103(a)--Amo in view of JP '377 and U.S. Patent No. 5,891,290 to Duerer et al.	15-16
4.	§103(a)--Amo in view of JP '377 and U.S. Patent No. 6,004,420 to Nakamura et al. (deriving from Claim 32)	16-17
5.	§103(a)--JP '377 and U.S. Patent No. 6,004,420 to Nakamura et al.	17-21
6.	§103(a)--JP '377 in view of U.S. Patent No. 6,004,420 to Nakamura et al., further in view of Amo (deriving from Claim 51)	21-22
7.	§103(a)--JP '377	22-24
VIII.	CLAIMS APPENDIX	25-28
IX.	EVIDENCE APPENDIX	29
X.	RELATED PROCEEDINGS APPENDIX	30

App. No. 10/016,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

I. REAL PARTY IN INTEREST

The real party in interest in the instant application is STEAG HAMATECH AG, and 3M INNOVATIVE PROPERTIES COMPANY, as assignees.

II. RELATED APPEALS AND INTERFERENCES

The Applicant is unaware of any related appeals or interferences to the application.

III. STATUS OF CLAIMS

Claims 32-40 and 42-62 remained pending prior to final rejection.

Claims 1-31 were originally filed. Claims 1-31 were cancelled by Preliminary Amendment and new Claims 32-62 were filed.

IV. STATUS OF AMENDMENTS

Claims 32-62 were rejected in a First Office Action dated September 25, 2003.

A Response was filed January 26, 2004 amending Claim 32 and canceling Claim 41.

A Second Office Action for a non-compliant amendment was mailed February 23, 2004.

An Amendment in Response was filed March 1, 2004 to effect compliance.

Claims 32-40 and 42-62 were finally rejected in a Third Office Action dated June 02, 2004.

An Amendment in Response was filed August 31, 2004 to the Third Office Action. It was argued that the Examiner's Third Office Action (with final rejections)

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

introduced a new ground of rejection not necessitated by Applicant's amendment of claims.

A Fourth Office Action was mailed September 13, 2004 making the previous rejections non-final.

An Amendment in Response was filed January 13, 2005 arguing against the rejections without claim modification.

A Fifth Office Action was mailed April 19, 2005 finally rejecting all outstanding claims 32-40 and 42-62.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 32 sets forth a method for producing a data carrier by adhering at least two substrates to one another by (1) providing a first substrate (*Specification, p. 8, line 1; Figure 1*), (2) pressing an adhesive film with two adhesive sides against the first substrate (*Specification, p. 8, lines 3-5; Figures 2 and 3*) with a rotating pressure roller (*Specification, p. 13, lines 5-7; p. 14, lines 8-14; Figures 2 and 3*) by moving the first substrate linearly past the pressure roller and in a movement parallel to the surface of the first substrate (*Specification, p. 12, line 10 through p. 13, line 18; Figures 2 and 3*), (3) aligning the second substrate to the first substrate (*Specification, p. 8, lines 10-20; p. 16, lines 1-4; Figures 4a-c*), and (4) joining the substrates together. (*Specification, p. 8, lines 10-20; p. 16, lines 5-6; Figures 4a-c*)

Independent Claim 51 sets forth an apparatus for producing a data carrier having at least two substrates adhered to one another comprising (1) a laminating station (*p. 9, line 13 through p. 12, line 9; Figures 1, 2, 3*) for applying a double-sided adhesive (*Specification, p. 8, lines 5-6; p. 9, line 15; Figures 2 and 3*) to a first substrate

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

(Specification, p. 8, line 1; p. 12, line 10; Figure 1) having a rotatable pressure roller (Specification, p. 13, line 1; Figures 2 and 3) and having a device (Specification, p. 12, lines 22-24 and p. 13, lines 1-17; Figures 2 and 3) for moving the first substrate linearly past the pressure roller during lamination and parallel to the surface of the first substrate and (2) a substrate adhering station (Specification, p. 13, line 20; Figures 2 and 3) for aligning and joining the first substrate and second substrate together.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 51-55 and 62 stand rejected under 35 U.S.C. §102(a) as anticipated by Japanese Patent No. 11-126377.

2. Claims 32-35, 37-41, 43, 44, 46-50 stand rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent 6,200,402 to Amo in view of Japanese Patent No. 11-126377.

3. Claim 36 stands rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,200,402 to Amo in view of Japanese Patent No. 11-126377 and U.S. Patent No. 5,891,290 to Deurer et al.

4. Claim 45 stands rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,200,402 to Amo in view of Japanese Patent No. 11-126377 and U.S. Patent No. 6,004,420 to Nakamura et al.

5. Claims 56-59 stand rejected under 35 U.S.C. §103(a) as obvious over Japanese Patent No. 11-126377 in view of U.S. Patent No. 6,004,420 to Nakamura et al.

6. Claim 60 stands rejected under 35 U.S.C. §103(a) as obvious over Japanese Patent No. 11-126377 in view of U.S. Patent No. 6,004,420 to Nakamura et

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

al. and further in view of U.S. Patent No. 6,200,402 to Amo.

7. Claim 61 stands rejected under 35 U.S.C. §103(a) as obvious over Japanese Patent No. 11-126377.

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

VII. ARGUMENT

1. §102(a)-- Japanese Patent No. 11-126377

Claims 51-55 and 62 stand rejected under 35 U.S.C. §102(a) as anticipated by Japanese Patent No. 11-126377 (hereinafter, JP '377). 35 U.S.C. §102(a) states:

A person shall be entitled to a patent unless . . . (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

35 U.S.C. §102(a).

The invention as set forth in independent Claim 51 (and therefore, dependent Claims 52-55 and 62) of the present application cannot be anticipated by the reference cited by the Examiner. Claim 51, sets forth:

51. An apparatus for producing a data carrier having at least two substrates that are adhered to one another, comprising:

a laminating station for applying to a first substrate an adhesive film that is adhesive on two sides, wherein said laminating station comprises a rotatable pressure roller and a device for moving said first substrate linearly past said pressure roller during lamination, wherein such movement extends parallel to a surface of said first substrate; and

a substrate adhering station for aligning and joining said first substrate and a second substrate together.

Given that this claimed apparatus for producing a data carrier which has at least two substrates adhered to one another (preamble) requires a laminating station

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

for applying to a first substrate an adhesive film that is adhesive on two sides, the cited reference does not contain each and every element of the invention, since JP '377 does not disclose nor even suggest a lamination station capable of applying double-sided adhesive film to substrates.

The cited reference, JP '377 is directed toward an "information signal layer formed on a substrate . . . covered with adhesive agent, to uniform thickness. A cementing layer consisting of ultraviolet cured resin is then [sp] formed on the information signal layer. Then a transparent plastic film (112) at strain condition is laminated on the cementing layer." (JP '377, Novelty Section, Derwent Abstract, p. 1, as Provided in First Office Action). The reference involves increasing capacity of an optical disc by using a thin transparent film of uniform thickness formed on the information signal layer. (JP '377, Advantage Section of Derwent Abstract, p. 2, as Provided in First Office Action). The reference describes in detail its application of the light transmission layer consisting of a transparent plastic on the substrate on which the information signal section was formed and the apparatus involved therein. (English translation p. 1, paragraph 0014 of Translation Provided in First Office Action) It is further described in the figures and text that the adhesives are spread as a liquid by "adhesive coaters", and that these adhesives will "flow" when placed on the substrate. It is further disclosed the adhesives must have a viscosity sufficient to allow such flow to prevent the adhesive from falling from the substrate. (See paragraphs 0019, 0020, 0026, 0028, 0030, and 0034 of JP '377 English Translation Provided in First Office Action and Figures 1 and 6 showing adhesive coaters 11 and disposed adhesive.) Therefore, there is no disclosure

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

of a lamination station capable of disposing a double-sided adhesive film on a substrate in JP '377. Instead, the reference teaches using liquid substance with a sufficient viscosity that "flows" onto the substrate as its adhesive. This adhesive is then used to adhere a thin film to the substrate. Clearly, the JP '377 reference actually teaches away from the present Application's laminating station for applying to a first substrate an adhesive film that is adhesive on two sides. "Anticipation under 35 U.S.C. § 102 . . . requires the presence in a single prior art disclosure of each and every element of a claimed invention." Electro Med. Sys. S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed.Cir.1994). JP '377 does not teach each and every element. As a result, there can be no anticipation under §102(a) since each and every element is not disclosed within the cited JP '377 reference.

The indication that the cited reference, JP '377 "discloses all the apparatus limitations of the applicant's claim", is incorrect. (p. 8, numbered paragraph 13, Fifth Office Action). The Examiner has indicated that since the JP '377 reference discloses a lamination station for application of the transparent film to the substrate, then the present application is anticipated since "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. " *citing Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) (p. 8, numbered paragraph 13, Fourth Office Action).

The Examiner seeks to take JP '377 (which discloses an "information signal layer formed on a substrate . . . covered with adhesive agent, to uniform thickness. A cementing layer consisting of ultraviolet cured resin is than [sic]

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

formed on the information signal layer. Then a transparent plastic film (112) at strain condition is laminated on the cementing layer." (JP '377, Novelty Section, Derwent Abstract, p. 1, as Provided in First Office Action)), and force it into the mold of the Applicant's Claim 51. She suggests that "[t]he film, whether adhesive or not, is material worked upon and does not add structure to the apparatus", apparently applying the Ex parte Thibault case law. However, that case involved a chemical application wherein the applicant sought to achieve patentability in a method claim with a "molten tank" over an existing apparatus patent having the individual elements needed to achieve the more generalized tank. Id. at 164 U.S.P.Q. 667. The Applicant respectfully asserts that this is an incorrect application of the case law, and that the present situation is clearly distinguishable. The Applicant in the case law was attempting to achieve the same results as the there existing patent but sought protection in a method claim instead of an apparatus claim. Here, the Applicant has described a novel apparatus for producing a data carrier having two adhered substrates, wherein the laminating station is a specialized one capable of applying a double-sided adhesive film. The cited reference here, JP '377, however, is not directed toward such, but instead, by its own description sees its advantage as "thin transparent film of uniform thickness is formed on the information signal layer [such that] capacity of [the] optical disc is increased" and does not disclose any laminating station, by its own description, capable of applying a double-sided adhesive film. (JP '377, Advantage Section, Derwent Abstract, p.2.) Instead, JP '377 actually teaches away from such by applying adhesive directly using adhesive coaters 11 and requiring adhesive having a particular viscosity. (JP

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

'377, English translation, p. 1, paragraph 0020; p. 2, paragraph 0030.) Unlike the Ex parte Thibault case, the present Applicant is not seeking to usurp the use of the apparatus of the cited reference, but instead seeks patent protection for its inventive apparatus for producing a data carrier having two adhered substrates, wherein the laminating station must apply a double-sided adhesive film. Therefore, the application of the case law cited is inappropriate in its application. The Applicant respectfully suggests that given such, and since "[a]nticipation under 35 U.S.C. § 102 . . . requires the presence in a single prior art disclosure of each and every element of a claimed invention", Electro Med. Sys. S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed.Cir.1994), then there can be no anticipation by JP '377. As a result, the Applicant respectfully request that the Examiner's rejections under §102(a) be withdrawn.

2. §103(a)--U.S. Patent 6,200,402 to Amo in view of JP'377

Claims 32-35, 37-41, 43-44, and 46-50 stand rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent 6,200,402 to Amo (hereinfter, "Amo", "Amo patent", or "Amo '402") in view of JP'377. 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Independent Claim 32, from which all the remaining claims of the rejected set depend, is set forth as follows:

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

32. A method of producing a data carrier by adhering at least two substrates to one another, said method including the steps of:

providing a first substrate;

pressing an adhesive film, which is adhesive on two sides, against said first substrate via a rotating pressure roller by moving said first substrate linearly past said pressure roller, wherein such movement extends parallel to a surface of said first substrate;

aligning a second substrate relative to said first substrate; and

joining said first and second substrates together.

The subject matter of Claim 32 as a whole would not have been obvious to a person having ordinary skill in the art. A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. In re Dembiczak, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed.Cir.1999). However, a critical step in analyzing the patentability of claims pursuant to §103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id., quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir.1983)). Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

USPQ2d 1453, 1457 (Fed.Cir.1998). Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See Id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.** See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.Cir.1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed.Cir.1984) (emphasis ours).

Claim 32 is not obvious over Amo in view of JP '377 since there is no suggestion or motivation to modify the teachings of either reference to make the specific combination that was made by the Applicant. The Examiner indicated that "Amo does not teach moving the substrate during lamination." (Second Office Action, p. 3, numbered section 4, paragraph 3.) The Examiner indicates in her rejection that "JP '377 discloses having the substrate move as a film is pressed thereon. [And], [i]t would have been obvious to one having ordinary skill in the art at the time the invention was made based on the teachings of JP '377 that an obvious alternative [sic] to having the pressure roller move past the substrate is to have the substrate move past the pressure roller, because the two actions are functionally equivalent expedients." (Second Office Action, p. 3, paragraphs 5 and 6.) However, the teachings of the references, their relatedness to the field of the applicant's endeavor, and the knowledge of persons of ordinary skill in the field of the invention, are all relevant considerations. See In re Dance, 160 F.3d 1339, 1342 (C.A.Fed., 1998), *citing In re Oetiker*, 977 F.2d at 1447, 24 USPQ2d at 1445-46; In re Gorman, 933 F.2d at 986-87, 18 USPQ2d at 1888; In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed.Cir.1991). When the

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed.Cir.1988) (emphasis ours). Therefore, for combination of the references to be proper, the Examiner would have to determine whether selection of the specific teachings she has applied from each reference are identified by some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. The Examiner has not referenced any such teaching or suggestion, but instead has said that the two actions are functionally equivalent expedients. The Applicant respectfully disagrees with the Examiner's conclusion and asserts that the proper showing of teaching or suggestion to combine the references and elements has not been made.

The Examiner's references may both be in the broad field of the manufacture of optical discs, however, the areas of art she seeks to combine differ enough that combination would not be obvious. The Amo reference is in the same field as the Applicant's invention, as it incidentally discusses adhering two substrates to provide a data carrier. However, the JP '377 reference is an unrelated area of the field for the proposition asserted. In JP '377, as is clearly shown in Fig. 5, the adhesive is applied in liquid form. The laminating station illustrated in Fig. 5 serves merely for laminating a protective layer onto the liquid adhesive layer which serves to adhere the protective layer to the substrate. Furthermore, it is not clear from JP '377 just how the laminating station does function, and whether during the laminating process the substrate is moved

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

by a device past a pressure roller and is moved parallel to the surface of the substrate-- as required by the elements of Applicant's independent Claim 32 (and therefore the dependent claims of the rejected set). JP '377 never discloses a laminating film, and there is no teaching or suggestion to use one. There is no teaching or suggestion in either reference to motivate the combination of the references or the particular elements of the references drawn out by the Examiner to "create" Applicant's claims. As a result, the combination can only be inappropriate hindsight. Therefore, the Applicant respectfully requests that the rejections be withdrawn.

3. **§103(a)--U.S. Patent 6,200,402 to Amo in view of JP'377 and U.S. Patent No. 5,891,290 to Deurer et al.**

Claim 36 stands rejected under 35 U.S.C. §103(a) as obvious over Amo '402 in view of JP'377 further in view of U.S. Patent No. 5,891,290 to Deurer et al. (hereinafter, "Deurer patent", "Deurer reference" Deurer '290). 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

As discussed in Section 2. above, Independent Claim 32, from which Claim 36 depends, is not obvious over the Amo patent in view of JP '377. As a result, all claims depending from such must not be obvious over these references unless a new reference which teaches or suggests the combination of the elements provides the missing elements and motivation for combination. The Examiner's stated rejection of Claim 36 regards the new reference Deurer only as to the differing element of Claim 36.

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

The remaining intervening claim elements are still only referred to as "shown" by Amo and JP'377. As a result, the arguments previously made regarding the improper combination of Amo and JP'377 (See Section 2.) are reasserted here. With regard to the applicability of the Deurer reference, Applicant respectfully asserts that the application is inappropriate here. Deurer in no way suggests any relation to the field of optical disc manufacture. There is no teaching or suggestion within Deurer or the Amo or JP '377 references to combine any of the them to achieve the invention of Claim 36 of the present application. As a result, the combination can only be improper hindsight. Therefore, the Applicant respectfully requests that the rejections be withdrawn.

4. **§103(a)--U.S. Patent 6,200,402 to Amo in view of JP'377 and U.S. Patent No. 6,004,420 to Nakamura et al.**

Claim 45 stands rejected under 35 U.S.C. §103(a) as obvious over Amo '402 in view of JP'377 further in view of U.S. Patent No. 6,004,420 to Nakamura et al. (hereinafter, "Nakamura patent", "Nakamura reference", or "Nakamura '420"). 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

As discussed in Section 2. above, Independent Claim 32, from which Claim 45 depends, is not obvious over the Amo patent in view of JP '377. As a result, all claims depending from such must not be obvious over these references unless a new

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

reference which teaches or suggests the combination of the elements provides the missing elements and motivation for combination. The Examiner's stated rejection of Claim 45 regards the new reference Nakamura only as to the differing elements of Claim 45. The remaining intervening claim elements are still only referred to as "shown" by Amo and JP'377. As a result, the arguments previously made regarding the improper combination of Amo and JP'377 (See Section 2.) are reasserted here. With regard to the applicability of the Nakamura reference, Applicant respectfully asserts that the application is inappropriate here. There is no teaching or suggestion within Nakamura '420 or the Amo or JP '377 references to combine any of the them to achieve the invention of Claim 45 of the present application. As a result, the combination can only be improper hindsight.

5. §103(a)– JP'377 in view of U.S. Patent No. 6,004,420 to Nakamura et al.

Claims 56-59 stand rejected under 35 U.S.C. §103(a) as obvious over JP'377 in view of U.S. Patent No. 6,004,420 to Nakamura et al. (hereinafter, "Nakamura patent", "Nakamura reference", or "Nakamura '420"). 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Section 1 discussed the §102(b) rejection for this reference. The Examiner in her Fifth Office Action, referenced the rejection of Claims 56-59 as obvious over JP'377

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

as applied in the §102(b) rejection, in view of Nakamura et al. (See Fifth Office Action, p. 6, numbered paragraph 9.)

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.. In re Dembiczak, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed.Cir.1999).

A critical step in analyzing the patentability of claims pursuant to §103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.*, quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir.1983)). Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir.1998). Thus, every element of a claimed invention may often be found in the prior art.. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, **there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.** See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.Cir.1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed.Cir.1984) (emphasis ours).

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

Claim 51 is not obvious over JP '377 in view of the Nakamura reference since there is no suggestion or motivation to modify the teachings of either reference to make the specific combination that was made by the applicant. The Examiner indicated that "JP '377 does not detail the manner in which the substrates are pressed together. However it would be obvious to one having ordinary skill in the art at the time the invention was made based on Figure 14 that the substrates are held apart and then pressed together in a centered manner. JP '377 does not disclose if the substrates are pressed together in a vacuum or not" (Fifth Office Action, p. 6, numbered section 9, paragraph 2.) The Examiner indicates in her rejection that "It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a vacuum in the bonding step in JP '377 because Nakamura shows that it is well known in the art to bond substrates together in a vacuum." (Fifth Office Action, p. 7, paragraph 2.) However, the teachings of the references, their relatedness to the field of the applicant's endeavor, and the knowledge of persons of ordinary skill in the field of the invention, are all relevant considerations. See In re Dance, 160 F.3d 1339, 1342 (C.A.Fed., 1998), *citing* In re Oetiker, 977 F.2d at 1447, 24 USPQ2d at 1445-46; In re Gorman, 933 F.2d at 986-87, 18 USPQ2d at 1888; In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed.Cir.1991). When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed.Cir.1988). Therefore, for combination of the references to be proper,

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

the Examiner would have to determine whether selection of the specific teachings she has applied from each reference are identified by some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. The Examiner has not referenced any such teaching or suggestion, but instead has said that the two actions are functionally equivalent expedients. The Applicant respectfully disagrees with the Examiner's conclusions and asserts that the proper show of teaching or suggestion to combine the references and the elements therein has not been made.

The Examiner's references may both be in the broad field of the manufacture of optical discs, however, the areas of art she seeks to combine differ enough that combination would not be obvious. The JP '377 reference is an unrelated area of the field for the proposition asserted. In JP '377, as is clearly shown in Fig. 5, the adhesive is applied in liquid form. The laminating station illustrated in Fig. 5 serves merely for laminating a protective layer onto the liquid adhesive layer which serves to adhere the protective layer to the substrate. Furthermore, it is not clear from JP '377 just how the laminating station does function, and whether during the laminating process the substrate is moved by a device past a pressure roller and is moved parallel to the surface of the substrate--as required by the elements of Applicant's independent Claim 51 (and therefore the dependent claims of the rejected set). JP '377 never discloses a laminating film, and there is no teaching or suggestion to use one. There is no teaching or suggestion in either reference to motivate the combination of the references or the particular elements of the references drawn out by the Examiner to "create" Applicant's claims. As a result, the combination can only be inappropriate hindsight. Therefore, the Applicant respectfully requests that the rejections be withdrawn.

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

6. §103(a)-- JP'377 in view of U.S. Patent No. 6,004,420 to Nakamura et al., further in view of U.S. Patent 6,200,402 to Amo

Claim 60 stands rejected under 35 U.S.C. §103(a) as obvious over JP'377 in view of U.S. Patent No. 6,004,420 to Nakamura et al. (hereinafter, "Nakamura patent", "Nakamura reference", or "Nakamura '420"), and further in view of Amo '402. 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

As discussed in Section 5. above, independent Claim 51, from which Claim 60 ultimately depends, is not obvious over the Amo patent in view of JP '377. As a result, all claims depending from such must not be obvious over these references unless a new reference which teaches or suggests the combination of the elements provides the missing elements and motivation for combination. The Examiner's stated rejection of Claim 60 regards the new reference Nakamura only as to the differing elements of Claims 60. The remaining intervening claim elements are still only referred to as "shown" by Amo and JP'377. As a result, the arguments previously made regarding the improper combination of Amo and JP'377 (See Section 2.) are reasserted here. With regard to the applicability of the Nakamura reference, Applicant respectfully asserts that such application is inappropriate here. There is no teaching or suggestion within Nakamura '420 or the Amo or JP '377 references to combine any of the them to

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

achieve the invention of Claim 60 of the present application. As a result, the combination can only be improper hindsight.

7. §103(a)--JP '377

Claim 61 stands rejected under 35 U.S.C. §103(a) as obvious over JP '377 applied to Claim 51. Since there is no §103(a) rejection of Claim 51, it was assumed that the reference to Claim 51 was for the §102(a) rejection made. 35 U.S.C. §103(a) sets forth that:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

As discussed in Section 5. above, Independent Claim 51, from which Claims 58, 60, and 61 depend, is not obvious over the JP '377 and certainly not even with the addition of the Amo patent as argued by the Examiner in the earlier rejection of claim 60.

Given that this claimed apparatus of Claim 61 is for producing a data carrier which has at least two substrates adhered to one another (preamble as depending ultimately from Claim 51), requires a laminating station for applying to a first substrate an adhesive film that is adhesive on two sides, the cited reference does not contain each and every element of the invention alone or in combination, since JP '377 does not disclose nor even suggest a lamination station capable of applying double-sided adhesive film to substrates and also does not in any way disclose the compressed air of Claim 61.

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006


Instead, as discussed in Section 1, the cited reference, JP '377 is directed toward an "information signal layer formed on a substrate . . . covered with adhesive agent, to uniform thickness. A cementing layer consisting of ultraviolet cured resin is then [sp] formed on the information signal layer. Then a transparent plastic film (112) at strain condition is laminated on the cementing layer." (JP '377, Novelty Section, Derwent Abstract, p. 1, as Provided in First Office Action). The reference involves increasing capacity of an optical disc by using a thin transparent film of uniform thickness formed on the information signal layer. (JP '377, Advantage Section of Derwent Abstract, p. 2, as Provided in First Office Action). The reference describes in detail its application of the light transmission layer consisting of a transparent plastic on the substrate on which the information signal section was formed and the apparatus involved therein. (English translation p. 1, paragraph 0014 of Translation Provided in First Office Action) It is further described in the figures and text that the adhesives are spread as a liquid by "adhesive coaters", and that these adhesives will "flow" when placed on the substrate. It is further disclosed the adhesives must have a viscosity sufficient to allow such flow to prevent the adhesive from falling from the substrate. (See paragraphs 0019, 0020, 0026, 0028, 0030, and 0034 of JP '377 English Translation Provided in First Office Action and Figures 1 and 6 showing adhesive coaters 11 and disposed adhesive.) Therefore, there is no disclosure of a lamination station capable of disposing a double-sided adhesive film on a substrate in JP '377, and no discussion of compressed air. Instead, the reference teaches using liquid substance with a sufficient viscosity that "flows" onto the substrate as its adhesive. This adhesive is then used to adhere a thin

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

film to the substrate. Clearly, the JP '377 reference actually teaches away from the present Application's laminating station for applying to a first substrate an adhesive film that is adhesive on two sides. JP '377 does not teach or suggest each and every element alone or in combination. As a result, there can be no obviousness under §103(a) since each and every element is not disclosed within the cited JP '377 reference.

In view of the foregoing discussion, it is respectfully requested that the Honorable Board of Patent Appeals and Interferences overrule the final rejection of claims 32-40 and 42-62 over the cited art, and hold that Appellants' claims be allowable over such art.

Respectfully Submitted,



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App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

VIII. CLAIMS APPENDIX

Listing of Claims Involved in the Appeal:

32. A method of producing a data carrier by adhering at least two substrates to one another, said method including the steps of:

providing a first substrate;

pressing an adhesive film, which is adhesive on two sides, against said first substrate via a rotating pressure roller by moving said first substrate linearly past said pressure roller, wherein such movement extends parallel to a surface of said first substrate;

aligning a second substrate relative to said first substrate; and

joining said first and second substrates together.

33. A method according to claim 32, which includes the step of withdrawing said adhesive film from a carrier film during or after application of said adhesive film against said first substrate.

34. A method according to claim 32, which includes the step of withdrawing a protective film from said adhesive film prior to application of said adhesive film against said first substrate.

35. A method according to claim 33, wherein a shape and size of said adhesive film corresponds to surfaces of said first and second substrates that are to be adhesively joined.

36. A method according to claim 35, wherein sections of said adhesive film that correspond to a shape and size of said first and second substrate are punched onto said carrier film.

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

37. A method according to claim 32, which includes the step of applying said adhesive film in a centered manner to a surface of said first substrate that is to be adhered.

38. A method according to claim 32, which includes the step of aligning said adhesive film and said first substrate with one another prior to said step of pressing said adhesive film against said first substrate.

39. A method according to claim 32, which includes the step of controlling a pressure of said pressure roller.

40. A method according to claim 32, which includes the step of holding said adhesive film at a pre-specified angle relative to a surface of said first substrate prior to said step of pressing said adhesive film against said first substrate.

41. (canceled)

42. A method according to claim 32, which includes the step of rotating said pressure roller synchronously to a movement of said first substrate.

43. A method according to claim 32, wherein said first and second substrates are placed on a centering and holding device for aligning said substrate.

44. A method according to claim 43, wherein prior to said joining step, said centering and holding device holds said first and second substrate spaced from one another.

45. A method according to claim 32, wherein said step of joining said first and second substrates together is effected in a vacuum.

46. A method according to claim 32, wherein said joining step includes pressing said first and second substrates together.

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

47. A method according to claim 46, which includes the step of controlling a pressure exerted upon said first and second substrates.

48. A method according to claim 32, wherein said adhesive film is an adhesive film that responds to pressure.

49. A method according to claim 32, wherein said adhesive film is hardened.

50. A method according to claim 32, wherein said adhesive film is a single layer of adhesive material.

51. An apparatus for producing a data carrier having at least two substrates that are adhered to one another, comprising:

a laminating station for applying to a first substrate an adhesive film that is adhesive on two sides, wherein said laminating station comprises a rotatable pressure roller and a device for moving said first substrate linearly past said pressure roller during lamination, wherein such movement extends parallel to a surface of said first substrate; and

a substrate adhering station for aligning and joining said first substrate and a second substrate together.

52. An apparatus according to claim 51, wherein a shape and size of said adhesive film corresponds to surfaces of said first and second substrates to be adhered.

53. An apparatus according to claim 51, wherein sections of said adhesive film that correspond to a shape and size of surfaces of said first and second substrates to be adhered are punched onto a carrier film.

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

54. An apparatus according to claim 51, wherein said laminating station is provided with an aligning unit for aligning said adhesive film with a surface of said substrate that is to be adhered.

55. An apparatus according to claim 54, wherein said aligning unit is provided with at least one linear movement unit for said substrate.

56. An apparatus according to claim 51, wherein a centering and holding device is provided that in a first position holds said first and second substrates spaced apart and in a second position enables a centered joining of said first and second substrates.

57. An apparatus according to claim 51, wherein said substrate adhering station is provided with a vacuum chamber.

58. An apparatus according to claim 57, wherein said vacuum chamber is provided with a hood and a base that is formed by a substrate support element.

59. An apparatus according to claim 56, wherein said substrate adhering station is provided with a pressure ram.

60. An apparatus according to claim 59, wherein said pressure ram is provided with an element for actuating said centering and holding device between said first and second positions.

61. An apparatus according to claim 51, wherein said substrate adhering station is provided with an apparatus for applying compressed air to at least one of said first and second substrates for pressing said substrates together.

62. An apparatus according to claim 51, wherein said adhesive film is a layer of adhesive material

App. No. 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

IX. EVIDENCE APPENDIX

None

App. No 10/018,144
SUBSTITUTE APPEAL BRIEF
20 November 2006

X. RELATED PROCEEDINGS APPENDIX

None

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DATE: November 20, 2006
TO: U.S.P.T.O.
ATTN: Examiner Sonya Mazumdar
RE: Substitute Appeal Brief for
U.S. Patent App. Ser. No. 10/018,144
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Comments:

Please find enclosed the Substitute Appeal Brief as we discussed on Friday. Please call me at (505) 468-0518 if any further changes are needed.

Best regards,

Katy Fain

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